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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,734	08/03/2001	Norman Yamamoto	310048-650	8752

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 07/18/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/921,734

Applicant(s)

YAMAMOTO ET AL.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-6,11,12,14-17,21,22 and 24-28 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 1,4-6,11,12,14-17,21,22 and 24-28 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Request for Continued Examination***

1. The request filed on April 22, 2003 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/921,734 is acceptable and an RCE has been established. An action on the RCE follows.

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2. Claims 1, 5, 11, 15, 17, 19, 21, 22, 24 have been amended for further examination.

***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

It does not include the notary's signature, or the notary's signature is in the wrong place.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4-6, 11, 12, 14-17, 21, 22, and 24-28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al (6,206,602) in view of Walters (5,118,137), and further in view of Brown et al (6,364,559), Wilson (5,590,911) and Wyant (4,991,767).

Yamamoto et al discloses in Fig. 2, a binder assembly and system comprising: front and rear plastic covers (12), wherein the front cover is transparent with an opaque frame coating (22, Col. 2, lines 58-60) defining an open area (as seen in Fig. 1); wherein the covers are secured together at a binding (16, 18 and 20); and an inner pocket (26) secured to the inner surface (12A) of the front cover (Col. 2, lines 60-65) and having inner, outer, top and bottom edges, permitting quick insertion of visual material information (30, as stated in Col. 2, lines 65-67) from a top (28) of the inner areas of the pocket.

However, Yamamoto et al does not disclose a binder assembly: wherein the inner pocket has the same dimensions as the cover and is secured along its outer edge and its bottom edge, but is free and unsecured to the cover at the top and inner edges; having a transparent dividers with

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outwardly projecting tabs which are mounted in the binder; wherein the rear cover having a partial pocket extending half the area of a rear cover and formed of the same sheet as the rear cover, with the pocket being folded upward and bonded, and wherein the rear cover is coated with opaque material; and wherein the inner edge of the pocket is cut along the binding.

Walters discloses in Fig. 5 and 6, a binder (Col. 2, line 12) having an inner pocket (20) dimensioned at any desirable size (Col. 2, lines 32-34) and is secured (sealed, as is stated in Col. 2, lines 17, 18 and 36 and 37) along its outer edge and its bottom edge, but is free and unsecured to the cover at the top and inner edges.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly and replace the pocket with a pocket only secured at its outer and bottom edge as taught by Walters for the purpose of allowing easier insertion of material in the pocket.

However, Yamamoto et al as modified by Walters does not disclose a binder assembly: having slits in the pockets; having a transparent dividers with tabs which are mounted in the binder; and wherein the rear cover having a partial pocket extending half the area of a rear cover and formed of the same sheet as the rear cover, with the pocket being folded upward and bonded, and wherein the rear cover is coated with opaque material.

Brown et al discloses in Fig. 5, a binder having an inner pocket (45) that is secured along its outer edge and its bottom edge, comprises slits (53).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's and Walter's binder assembly and replace the pocket a pocket having slits as taught by Brown et al for the purpose of holding additional information.

However, Yamamoto et al as modified by Walters and Brown et al does not disclose a binder assembly: having a transparent dividers with tabs which are mounted in the binder; and wherein the rear cover having a partial pocket extending half the area of a rear cover and formed of the same sheet as the rear cover, with the pocket being folded upward and bonded, and wherein the rear cover is coated with opaque material.

Wilson discloses in Fig. 7, 8 and 9, a binder assembly having mounted dividers (70) with outwardly projecting tabs (72) as is stated in Col. 4, lines 35 and 36.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly to include mounted dividers as taught by Wilson for the purpose of organizing sheet information placed in the ring binder.

However, Yamamoto et al as modified by Walters, Brown et al and Wilson does not disclose a rear cover having a partial pocket extending half the area of a rear cover and formed of the same sheet as the rear cover, with the pocket being folded upward and bonded, and wherein the rear cover is coated with opaque material.

Wyant discloses in Fig. 1, 3, and Col. 1, lines 5-10, an assembly which could be a binder assembly comprising a rear pocket (47) having a folded up first area (36) and a folded down

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second area (lower portion of 42) to secure the pocket in its folded position, wherein the pocket is secured along its outer edges.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly to include a pocket formed with a folded up first portion and a folded down second portion as taught by Wyant for the purpose of providing a more securely reinforced pocket.

In regards to **Claim 1 and 4**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include any type of desirable material on the cover and partial pocket, whether it is transparent or opaque, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claim 6**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the slits on any desired cover, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regards to **Claims 5, 11 and 24**, it is notoriously well known in the art to print out visual display information previously constructed and displayed on a computer.

In regards to **Claims 25-28**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the inner edge of the pocket at any desired width of the cover, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. The pocket will hold the visual inserts securely



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whether the inner edge is formed along at a binding region (covering basically the entire cover width), or at 3/4 the width dimension of the cover.

### ***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Casper, Kogutt et al, Robinson, Walters, Walters ('701), Grimsley, Ho, and Wyant ('275).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1, 4-6, 11, 12, 14-17, 19-22, and 24-28 have been considered but are moot in view of the new ground(s) of rejection.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, a. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

July 10, 2003



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